

REMARKS

Status of Prosecution

Applicant filed the original application on February 18, 2004. The Examiner mailed a first, nonfinal office action on September 13, 2006. This paper is in Reply to that office action. Applicant requests reconsideration and withdrawal of the rejections raised in that office action.

In the Drawings

As provided in 37 C.F.R. §1.85 and MPEP §608.02(b), the informal drawing Figures that accompanied the filed Application will be replaced by formal drawings following issuance of a Notice of Allowance.

In the Specification

The term “appetency” as used, for example, in the Application on page 5, paragraph [1025], should in fact be “apparency.” Following issuance of a Notice of Allowance, Applicant will submit amendments correcting the terms.

Examiner’s General Objections and Rejections

Claims 1-45 are pending.

In the Office Action, the Examiner rejected claims 1-45.

(1) REAL PARTY IN INTEREST

The real party in interest is Qualcomm Incorporated, 5775 Morehouse Drive, San Diego, California 92121.

(2) STATUS OF CLAIMS

Claims 1-45 are pending in the application.

Claims 1-45 stand rejected.

The claims are set forth in the Listing of Claims.

(3) GROUNDS FOR REJECTION

A. Claims 1-4, 6-12, 15-20, 22-27, 30-33, 36-39, and 41-45 stand rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 5,917,433 to Keillor, *et al.* ("Keillor Patent").

B. Claims 5, 13-14, 21, 28-29, 34-35, and 40 stand rejected under 35 U.S.C. §103(a) as unpatentable over the Keillor Patent in view of Published U.S. Patent Application No. 2005/0145688 filed by Milenkovic, *et al.* ("Milenkovic Application").

Applicant respectfully urges the Examiner to withdraw the rejections.

(4) ARGUMENTS

A. Claims 1-4, 6-12, 15-20, 22-27, 30-33, 36-39, and 41-45 Not Anticipated Under 35 U.S.C. § 102(b) by Keillor Patent

1. **Rejection of Independent Claims 1, 10 and 17** On pages 2-6 of the Office Action the Examiner rejected independent claims 1, 10, and 17 (and dependent claims 2-4, 6-9, 11-12, 15-17, 18-20, and 22-25) as anticipated by the Keillor Patent, arguments that Applicant respectfully traverses. Accordingly, Applicant respectfully urges the Examiner to withdraw the rejections.

35 U.S.C. §102(b), cited by the Examiner as the basis for rejection of independent Claims 1, 10 and 17 provides:

"A person shall be entitled to a patent unless –

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States...."

Applicant respectfully submits that the present invention was neither patented nor described in a printed publication in this or a foreign country, nor was it in public use nor on sale

in this country, more than one year prior to the date of filing of the present application in the United States. Instead, independent claims 1, 10 and 17 are patentable (and therefore dependent claims 2-4, 6-9, 11-12, 15-17, 18-20, and 22-25 are patentable) because the Keillor Patent does not anticipate independent claims 1, 10 and 17 at least for the following reasons:

a. **Synopsis of Arguments**

1) The Keillor Patent does not satisfy the “all-elements” rule of MPEP §2131.

2) The Examiner acknowledges on page 7 of the Office Action that the Keillor Patent does not include a number of elements disclosed and claimed in the Application under examination by observing that (i) the Keillor Patent “does not explicitly show that [the] processor generates a list of appetency [apparency] actions in response to receiving [a] request;” (ii) does not provide for “a transmitter for transmitting the list of available appetency [apparency] actions to a remote entity;” and (iii) does not provide for “a receiver [for receiving] a second request for making the asset apparent [in which the second request comprises] a selected appetency [apparency] action from a list of appetency [apparency] actions.”

3) While the Keillor Patent includes terms that are similar to or identical with terms used by Applicant in the Application, the terms neither (i) describe the same structural components, nor (ii) have the same contextual meanings as shown by the specification, nor (iii) describe or claim structural components that cooperate in the same manner.

b. **All-Elements Rule Not Met Regarding Claims 1 and 17.** More specifically, the Keillor Patent does not satisfy the “all-elements” rule of MPEP §2131, which provides:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference...The identical invention must be shown in as complete detail as contained in the claim...[and] the elements must be arranged as required in the claim. (Emphasis added)

The Keillor Patent neither describes nor claims an “interface for providing the command to a device on the asset...for making the asset apparent to the individual.” See independent claim 1, page 16 of the Application, and independent claim 17, page 18.

On page 2 of the Office Action the Examiner asserts that the Keillor Patent at column 15, lines 40-50 contemplates such an interface. Applicant respectfully disagrees. That reference expressly refers to an operator interface 50 (emphasis added). As amplified in the Keillor Patent at column 4, lines 8-22, the apparatus of the Keillor Patent contemplates “an operator interface...mounted within the cab of a tractor or truck.” (Emphasis added.)

Claims 1 and 17 of the Application, however, are not directed to an operator interface mounted in the cab of a tractor or truck, but an interface mounted on the asset itself. (Emphasis added.) See also Application, page 1, paragraph [1005] (“...the apparatus comprises an interface for providing the command to a device on the asset [which is the device] for making the asset apparent to the individual.”)

In addition, the specification clearly describes the “device” that makes the “asset” apparent: “Ultimately, asset 106 [as shown in Figure 1] makes itself apparent...by performing one or more actions, such as by illuminating one or more lights connected to asset 106, by sounding an audible alert, or by moving a mechanical portion, or all of, asset 106.” See Application, pages 3-4, paragraph [1018] beginning on page 3.

It follows, therefore, that the term “operator interface” described in the Keillor Patent, and the term “interface” used in the Application, describe structural elements that co-operate and function in completely different ways.

Therefore, the Keillor Patent does not anticipate independent claims 1 and 17 of the Application.

c. **All-Elements Rule Not Met Regarding Claim 10** The Keillor Patent neither describes nor claims an “input for allowing the individual to enter an identification code corresponding to the asset...” See Application, Claim 10, page 16. On page 4 of the Office Action the Examiner asserts that the Keillor Patent teaches such an input at column 3, lines 45-54. Applicant respectfully disagrees.

While lines 45-54, column 3, of the Keillor Patent discuss the possibility of a transceiver “for establishing a first communications link between the asset monitor and the remotely located central station,” no mention is made of an input allowing entry of an identification code.

In addition, the Keillor Patent neither describes nor claims a “processor for receiving the input and generating a request to make the asset apparent, the request including the identification code....” On page 4 of the Office Action the Examiner asserts that the Keillor Patent at column 10 contemplates such a processor, column 10, lines 47-64. Applicant respectfully disagrees.

In fact, that reference describes a possible step by which the asset monitor of the Keillor Patent processes “communications signals which were transmitted by the central station....” This exemplifies use of similar or identical terms that do not have the same meanings in the respective documents, and consequently describe and claim instead structure and co-operation of structure for apparatus and methods that are quite different.

The processor of the Keillor Patent does not contemplate use of an identification code. The processor of the Application is not limited the “input” coming from a “central station.”

It follows, therefore, that the term “process” described in the Keillor Patent, and the term “processor” used and claimed in the Application, describe structural elements that co-operate and function in completely different ways.

Therefore, the Keillor Patent does not anticipate independent claim 10 of the Application.

2. **Rejection of Independent Claims 26, 32 and 38** On pages 2 and 5-6 of the Office Action the Examiner rejected independent claims 26, 32, and 38 relating to signal-bearing media for performing methods of operations (and dependent claims 25-27, 30-31, 33, 36-37, 39, and 41-45) as anticipated by the Keillor Patent, an argument that Applicant respectfully traverses. Accordingly, Applicant respectfully urges that the Examiner withdraw the rejections.

As predicate to the Applicant’s reasons for traversing the rejections, Applicant adopts and incorporates by reference all the above statements and arguments.

Applicant submits that the present invention was neither patented nor described in a printed publication in this or a foreign country, nor was it in public use, nor on sale in this country, more than one year prior to the date of filing of the present application in the United

States. Instead, independent claims 26, 32, and 38 are patentable (and therefore dependent claims 25-27, 30-31, 33, 36-37, 39, and 41-45 are patentable) because the Keillor Patent does not anticipate independent claims 26, 32, and 38 at least for the following reasons:

a. **Synopsis of Arguments.**

1) The Keillor Patent does not satisfy the “all-elements” rule of MPEP §2131.

2) The Examiner acknowledges on page 7 of the Office Action that the Keillor Patent does not include a number of elements disclosed and claimed in the Application under examination by observing that (i) the Keillor Patent “does not explicitly show that [the] processor generates a list of appetency [apparency] actions in response to receiving [a] request;” (ii) does not provide for “a transmitter for transmitting the list of available appetency [apparency] actions to a remote entity;” and (iii) does not provide for “a receiver [for receiving] a second request for making the asset apparent [in which the second request comprises] a selected appetency [apparency] action from a list of appetency [apparency] actions.”

3) While the Keillor Patent includes terms that are similar to or identical with terms used by Applicant in the Application, the terms neither (i) describe the same structural components, nor (ii) have the same contextual meanings as shown by the specification, nor (iii) describe or claim structural components that cooperate in the same manner.

b. **All-Elements Rule Not Met Regarding Claims 26** The Keillor Patent neither describes nor claims “a signal-bearing medium tangibly embodying a program of machine-readable instructions executable by a digital process apparatus to perform a method for making an asset apparent, said method...comprising the operations of...receiving an identification code corresponding to said asset [and] transmitting [a] request directly to said asset corresponding to said identification code.” See claim 26, Application, page 18, emphasis added. On page 5 of the Office Action the Examiner asserts that such a signal-bearing medium for performing the

method is contemplated by the Keillor Patent at column 10, lines 47-64. Applicant respectfully disagrees. That reference includes no suggestion or teaching, either expressly or implicitly, of receiving and transmitting an identification code, and certainly not directly to an asset.

c. **All-Elements Rule Not Met Regarding Claims 32** Likewise, the Keillor Patent neither describes nor claims “a signal-bearing medium tangibly embodying a program of machine-readable instructions executable by a digital process apparatus to perform a method for making an asset apparent, said method...comprising the operations of...receiving an identification code corresponding to said asset [and] transmitting [a] request to said asset corresponding to said identification code over a wireless communication network.” See claim 32, Application, pages 19-20, emphasis added. On page 5 of the Office Action the Examiner asserts that such a signal-bearing medium for performing the method is contemplated by the Keillor Patent at column 10, lines 47-64. Applicant respectfully disagrees. That reference includes no suggestion or teaching, either expressly or implicitly, of receiving and transmitting an identification code to an asset.

d. **All-Elements Rule Not Met Regarding Claims 38** Also, the Keillor Patent neither describes nor claims “a signal-bearing medium tangibly embodying a program of machine-readable instructions executable by a digital process apparatus to perform a method for making an asset apparent, said method...comprising the operations of...providing [a] command to a device on the asset...” See claim 38, Application, page 21, emphasis added. On page 5 of the Office Action the Examiner asserts that such a signal-bearing medium for performing the method is contemplated by the Keillor Patent at column 10, lines 47-64. The Examiner appears not to address the fact that the device is on the asset; see the above discussion in connection with independent claims 1 and 17. Applicant respectfully disagrees with the Examiner’s argument. The reference includes no suggestion or teaching, either expressly or implicitly, of receiving and transmitting a command to a device on the asset.

e. **Dependent Claims** Because independent claims 26, 32, and 38 are patentable as not anticipated by the Keillor Patent, dependent claims 25-27, 30-31, 33, 36-37, 39, and 41-451, 10 and 17 are patentable are also patentable. Thus, in view of the foregoing demonstration of the patentability of independent claims 26, 32, and 38, the dependent claims are, of course, also patentable because they are directly or indirectly dependent on independent claims 26, 32, and 38.

3. **Discussion of Rejections under 35 U.S.C. §102** The fundamental teaching on the doctrine of anticipation was set forth by Judge Rich in *In re William J. King*, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986):

It is axiomatic that anticipation of a claim under §102 can be found only if the prior art reference discloses every element of the claim.

In re William J. King at 231 USPQ 139 (emphasis added).

Further, as provided in MPEP §2131, for a reference to anticipate a claim, that reference must teach, or identically describe, each and every element or step of the claim in the identical orientation. *Atlas Powder v. E.I. duPont*, 750 F.2d 1569, 224 USPQ 409 (Fed. Cir. 1984); *Jamesbury Corp. v. Litton Industrial Products*, 756 F.2d 1556, 225 USPQ 253 (Fed. Cir. 1985) (emphasis added). “Anticipation” is a restrictive concept, requiring the presence in a single prior art disclosure of each and every element of a claimed invention. Further, as held in *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ2d 1001, 18 USPQ2d 1896 (Fed. Cir. 1991), “there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention.” (Emphasis added)

MPEP §2111.01 clearly requires that “...pending claims must be given their broadest reasonable interpretation consistent with the specification.” Accordingly, while the terms used to describe various elements are similar, the terms describe structural components that cooperate in completely different ways. Terms must be viewed “in light of the specification.”

Applicant, therefore, respectfully urges that the Keillor Patent does not anticipate claims 1, 10 or 17, and that the rejections be withdrawn.

B. Claims 5, 13-14, 21, 28-29, 34-35, and 40 Are Patentable Under 35 U.S.C. §103 over the Keillor Patent in view of the Milenkovic Patent

1. On pages 7-8 of the Office Action the Examiner rejected independent claims 26, 32, and 38 (and dependent claims 5, 13-14, 21, 28-29, 34-35 and 40) under 35 U.S.C. §103(a), claiming obviousness over the Keillor Patent in view of the Milenkovic Patent, an argument that Applicant respectfully traverses. Accordingly, Applicant respectfully urges the Examiner to withdraw the rejections.

35 U.S.C. §103(a) provides:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Applicant respectfully submits that the differences between the subject matter sought to be patented, and the references cited by the Examiner, are not such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

As predicate to overcoming the rejections of the claim, Applicant adopts and incorporates by reference the arguments made in connection with the rejections under 35 U.S.C. §102 above.

2) The Examiner acknowledges on page 7 of the Office Action that the Keillor Patent does not include a number of elements disclosed and claimed in the Application under examination by observing that (i) the Keillor Patent “does not explicitly show that [the] processor generates a list of appetency [apparency] actions in response to receiving [a] request;” (ii) does not provide for “a transmitter for transmitting the list of available appetency [apparency] actions to a remote entity;” and (iii) does not provide for “a receiver [for receiving] a second

request for making the asset apparent [in which the second request comprises] a selected appetency [apparency] action from a list of appetency [apparency] actions.”

The Examiner argues, however, that the Milenkovic Application does, and that therefore it would have been obvious to combine the Keillor and Milenkovic references.

Applicant respectfully disagrees.

a. **Primary/Secondary References** A secondary reference cannot correct the deficiencies of a primary reference. Accordingly, the Milenkovic Application cannot correct the deficiencies of the Keillor Patent.

b. **Different Structure and Cooperation of Structure** A review of the respective face sheets of the Keillor Patent and Milenkovic Application reveals that the International Classification and the U.S. Classification of that which is disclosed in the two references are completely different.

Further, both the specification and the claims of the Milenkovic Application confirm that the subject matters of the two references are different. For example, the claim 1 of the Milenkovic Application is directed to a “plurality of electronic devices” include a “physical-tag reading device” and a “logical-tag reading device.” See claim 1, Milenkovic Application, page 13. The terms “physical tag” and “logical tag” are expressly defined in the Milenkovic Application. See Milenkovic Application, page 2, paragraph [0025]. A person skilled in the art would readily appreciate that the Milenkovic Application is limited to tracking “electronic devices”: see Milenkovic Application, page 2, paragraph [0028].

These observations lead to the following arguments of Applicant.

c. **No Suggestion, Motivation, or Teaching** As stated in the MPEP §706.02(j), to establish a *prima facie* case of obviousness, three basic criteria must be satisfied: (1) a suggestion or motivation to modify the cited reference or to combine the teachings in the cited references; (2) a reasonable expectation of success; and (3) the cited references must teach or suggest all the

claim limitations. The cited reference “must expressly or impliedly suggest the claimed invention...” (Emphasis added)

As also provided in MPEP §2143.01, the “mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.”

Also, and rather significant in this instance, Applicant’s disclosure should not be used as a blueprint to reconstruct the claimed coupler out of isolated teachings in the prior art. *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir., 1988).

Indeed, in connection with all §103 arguments advanced by the Examiner, Applicant submits that the attempted combinations urged by the Examiner are individually and collectively impermissible hindsight prohibited by both the Board of Patent Appeals and Interferences (“Board”), and the Court of Appeals for the Federal Circuit (“CAFC”). The case of *Ex parte Wessels and Kaido*, Appeal No. 2004-0462, Application No. 09/915, 861, is an example. While the case is not binding precedent of the Board, the methodology of analysis based on *In re Fritch* is instructive:

[I]t is our opinion that the examiner has used the hindsight benefit of appellant’s own disclosure to pick and choose elements or concepts from the distinctly different systems of the applied references, and then selectively combine the chosen disparate elements or concepts in an attempt to reconstruct appellant’s claimed subject matter. However, as our court of review [CAFC] indicated in *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992), it is impermissible to use the claimed invention as an instruction manual or “template” in attempting to piece together isolated disclosures and teachings of the prior art so that the claimed invention is rendered obvious. (Emphasis added.)

In view of these ageless references about what is “obvious” under 35 U.S.C. §103(a), Applicant respectfully urges that the claims be allowed. The structure as both disclosed in the Application, and claimed, differs from the structure disclosed in the references. The references cited by the Examiner do not disclose the cooperation of structure of Applicant’s coupler. The references disclose no teaching or suggestion to support the notion that the coupler is obvious in view of the combination of references cited by the Examiner.

Additionally, all claim limitations must be considered, especially when missing from the alleged prior art. That is because 35 U.S.C. §103 is concerned with differences between the subject matter sought to be patented, and the alleged prior art, with the subject matter sought to be patented viewed as a whole. *In re Fine*, 873 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir.1988).

d. **Dependent Claims** Regarding rejections of dependent claims under 35 U.S.C. §103, as provided in MPEP §2143.03, if an independent claim is nonobvious under §103, then any claim depending therefrom is also nonobvious. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir.1988).


CONCLUSIONS

For the reasons set forth above, Applicant respectfully requests reconsideration and withdrawal of the rejection of all claims.

In conclusion, Applicant respectfully asserts that this Reply is complete as contemplated in 37 CFR §1.111, that all claims in the Application are patentable for the reasons set forth above, and that the Application is now in condition for allowance. Accordingly, Applicant respectfully requests an early notice of allowance. The Examiner is requested to call the undersigned at for any reason that would advance the instant application to issue.

Respectfully submitted,

Dated: July 21, 2007

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